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09/783,726	02/14/2001	Mihal Lazaridis	1400-1072 D2	7167

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RESEARCH IN MOTION
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EXAMINER	
STRANGE, AARON N	

ART UNIT	PAPER NUMBER
2448	

NOTIFICATION DATE	DELIVERY MODE
04/29/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

portfolioprosecution@rim.com

Office Action Summary	Application No.	Applicant(s)	
	09/783,726	LAZARIDIS ET AL.	
	Examiner	Art Unit	
	AARON STRANGE	2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *102-129* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *102-129* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimers filed on 1/17/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Application No. 10/207,418 and U.S. Application N. 09/782,107 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Amendment

2. Applicant's amendments are sufficient to overcome the objection to the specification under 37 C.F.R. 1.75(d)(1). That objection has been withdrawn.

3. Applicant's amendments to claim 113 are sufficient to overcome the rejection of claims 113-121 under 35 U.S.C. § 101. That rejection has been withdrawn.

Response to Arguments

4. Applicant's remaining arguments filed 1/17/2009 have been fully considered but they are not persuasive.

5. With regard to claim 102, and Applicant's assertion that Airmobile "does not teach or suggest ... receiving and processing an automatically generated notification at a redirector component" since AirMobile teaches polling the user's inbox at the mail server (Remarks 20-23), the Examiner respectfully disagrees. The Examiner agrees

that the AirMobile system polls the user's inbox periodically, as evidenced by the AirMobile Server reference.

However, the mere fact that the mail server is periodically polled does not preclude automatic generation of a notification, in response to receipt (and detection) of a user data item, or subsequently transmitting the notification to the redirector component. In fact, since the redirector component is notified of the newly received message, some type of notification must be sent to the redirector component.

The AirMobile reference is silent regarding whether this notification is generated automatically or in response to some type of user action. However, it seems very unlikely that a notification sent from the mail server to the redirection component would require any sort of user action to occur. While the AirMobile reference remains silent regarding the degree of intervention required to generate the notification, the Carthy reference teaches automatically generating and sending a notification upon receipt of an incoming electronic mail message, and the combination of the references teaches automatic generation of notifications in response to receipt of a user data item (electronic mail).

6. With further regard to claim 102, and Applicant's assertion that combining Carthy with the AirMobile reference "would change the principle of operation" of AirMobile, since "one must accept that the server polling mechanism is the essential principle of the operation [of the AirMobile system]" (Remarks 24-25), the Examiner respectfully

disagrees. The Examiner disagrees with the characterization of AirMobile's "essential principle of operation" as being the server polling mechanism.

The AirMobile system is a system for redirecting electronic messages to a wireless device. The mechanism by which it determines the receipt of a new message is a minor portion of the system, and certainly not critical to its operation. There is very little difference between a client device polling the server for new information and the server unilaterally notifying the client of the availability of new information. One of ordinary skill in the art would have recognized that these two methods are merely predictable variations of each other having no affect on the ability of the system to redirect received messages to a wireless device.

Therefore, Applicant's assertion that the combination of AirMobile and Carthy would alter "the basic architecture of AirMobile" is not persuasive, and the Examiner maintains that the combination is permissible.

7. With further regard to claim 102, and Applicant's assertion that there would be no reasonable expectation of success in combining AirMobile and Carthy (Remarks 25-27), the Examiner respectfully disagrees. Applicant's arguments appear to rely primarily on the premise that the MAPI interface taught by Carthy could not be combined with the VIM interface used by AirMobile.

As an initial matter, it is noted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in

any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, Carthy's teaching of using an automatic notification of receipt of an electronic message would have taught and/or suggested two possible modifications to one of ordinary skill in the art. First, the AirMobile system could have been modified to use a similar, VIM-based, automatic notification mechanism. Alternatively, the VIM interface could have been replaced with a MAPI interface or modified to interact with the MAPI notification routine taught by Carthy.

While Applicant characterizes VIM and MAPI as "altogether different" (Remarks 26-27), Boyer et al. (US 6,401,112) discloses that "the VIM and MAPI software layers are very similar" and that methods to synchronize email messages between portable clients and associated host computers can be used with equal success on systems using either MAPI or VIM (col. 6, ll. 7-10). In light of this characterization of MAPI and VIM, one of ordinary skill in the art would have had a reasonable expectation of success in creating a VIM-based notification routing similar to Carthy's MAPI notification routine or modifying the AirMobile system to use the MAPI routine.

8. With further regard to claim 102, and Applicant's assertion that, in Carthy, "there seems to be no bearing on how a polling-based software application may receive notifications without a 'live' connection to the messaging server" (Remarks 28), it is

noted that the current claims contain no limitations precluding a "live" connection to the messaging server or any similar limitation. Therefore, this argument is not persuasive.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 102-104, 106-113, 115-122 and 124-129 are rejected under 35 U.S.C. § 103(a) as being unpatentable over AirMobile (Software for Lotus cc:Mail Wireless, Communication Client Guide, Motorola, 1995) and Carthy et al. (MAPI Developers Forum post "MAPI Notification" April 12, 1996; hereinafter Carthy) and Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston").

11. With regard to claim 102, AirMobile disclosed a method of pushing user data items from a messaging host system ("communication server") in real-time delivery to a wireless mobile data communications device that is associated with a computer (Le. the mobile device in AirMobile is in and of itself a computer) connected over a network to the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server,

and the mail account is associated with a mobile device according the device ID), the method comprising:

Receiving a notification at a redirector component indicating receipt of a user data item by the messaging host system, where the notification is generated in response to receipt of the user data item at the messaging host system and wherein the user data item is addressed to a data store that is associated with the messaging host system and is viewable via the computer (e.g. Airmobile pushes received messages to the mobile clients and this push algorithm is invoked by some internal notification; see inter alia pgs 30 and 31 "enables messages to be immediately downloaded when they are received"];

Processing the user data item at the redirector component to add address information associated with the wireless mobile data communication device (required for delivery to the mobile client, see pg 31 ¶s 1-3);

Causing to send the user data item to the wireless mobile data communication device over a wireless network (the actual push or download of the message to the mobile device pg 31, ¶s 1-3), whereby the user data item is pushed to the wireless mobile data communication device in real-time (AirMobile discloses that the messages are “immediately downloaded when they are received” (p. 30). Messages delivered immediately upon receipt are delivered in "real-time".)

AirMobile disclosed the invention substantially as claimed, however Airmobile failed to specifically recite 1) that the notification is automatically generated in response

to receipt of the user data item and 2) transmitting a copy of the received electronic message.

With regard to point (1), AirMobile failed to specifically recite that the notification is automatically generated in response to receipt of the user data item. AirMobile disclosed a server side push technology (pg 31 ¶ 1-3), where the server must internally poll for the arrival on new messages in a user's mailbox. Nonetheless Examiner maintains that such an automatic notification must occur in the system in order for the actual forwarding software to be invoked within the computer system. Furthermore even if one were to argue persuasively that such a notification is not inherent then Examiner maintains that adding a new data item automatic notification feature would have been an obvious modification to AirMobile at the time of Applicant's invention, in view of at least Carthy. In a similar art, Carthy disclosed an e-mail system where the notification of new messages in a user's mailbox is sent automatically, as opposed to polling, using an extended MAPI IMAPIadviseSink notification (See the Carthy post describing "full asynchronous" notification in extended MAPI). Carthy further disclosed that in order to receive these automatic notifications the system must register with a software interface associated with the messaging server (i.e. registering with the ImsgStore to receive adviseSinks). Cathy also disclosed that automatic notification is preferable to polling (see the Cohen post below: "Today I do a polling on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do the same actions. It's not great ☹. So I'd like to know

whether -there- exists another way to notify with MAPI, especially a "fully asynchronous" notification"). Automatic notification is preferable to polling for detecting the arrival of new messages since the detection process is more efficient. For example the system no longer has the delay associated with polling each user's mailbox and is instead alerted immediately of the arrival of new messages. Additionally less system resources are consumed since the system no longer has to poll the mailbox of each user in order to detect new messages. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the automatic notification functionally disclosed by Carthy within AirMobile's system, since Carthy disclosed automatic notification is preferable to polling and further since the use of automatic notification is more efficient. Again automatic notification is more efficient since the system is alerted immediately of the arrival of new messages and less system resources are consumed.

With regard to point (2), AirMobile discloses forwarding messages received at the messaging server to the wireless device. However, AirMobile does not explicitly state that the messages forwarded to the wireless mail system are a copy. Nonetheless, most e-mail systems that forward messages actually replicate the messages before forwarding, so that a copy of the message is retained in the initial destination mailbox. Such replication is disclosed by Eggleston. In a similar art, Eggleston teaches a system for forwarding messages from a LAN-based host through a wireless host to a mobile client device, wherein the LAN-based host stores messages, thereby maintaining a replica of the messages, before forwarding them to the client (col. 4, lines 44-51; col.

12, lines 32-39, 59-62, wherein the messages are copied and maintained at a host system, and are also sent to target units). Thus, given the teaching of Eggleston, a person having ordinary skill in the art would have readily recognized the desirability and advantages of replicating the messages at the messaging server taught by AirMobile, to preserve received messages in case the client memory fails or the message is lost in transmission. Therefore, it would have been obvious to include the mail replication feature taught by Eggleston in the mail forwarding system taught by AirMobile and Carthy.

12. Claims 113 and 122 are rejected under the same rationale as claim 102, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

13. With regard to claim 103, AirMobile disclosed the redirector component is operating on the messaging host system (pg 9 "communication server" and pg 31 ¶s 1-3).

14. With regard to claim 104, AirMobile disclosed the' redirector component is operating on a host system that is couple to the message host system via the network (e.g. the Network file server cc:Mail Postoffice works in tandem with the Windows AirMobile server pg 9).

15. With regard to claim 106, Eggleston disclosed that messages sent between the wired and wireless systems can be compressed (col. 11, lines 63-67). Given this knowledge, it would have been obvious to a person having ordinary skill in the art to compress the messages, prior to transmission to the gateway, and to decompress the messages at the mobile device, as suggested by Eggleston, in order to increase available bandwidth and to provide faster and less expensive communications (see Eggleston, col. 12, lines 7-9).

16. With regard to claim 107, AirMobile disclosed the processing step further comprises encoding the copy of the user data item (e.g. transforming a message into the required transmission protocol for the wireless network being utilizing prior to pushing a message to the user) (additionally compressing as set forth with regard to claim 106 is a form of encoding).

17. With regard to claim 108, Examiner takes official notice that the Multipurpose Internet Mail Extensions protocol was widely known and used to communicate email messages between devices at the time of Applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to encode messages using the MIME protocol within AirMobile' s system in order to communicate messages between devices using a known reliable protocol.

18. With regard to claim 109, AirMobile disclosed the user data item is an email (pg. 38, "Sending/Transmitting e-mail messages").

19. With regard to claim 110, AirMobile disclosed the data store address is an email mailbox at the messaging host system associated with a user of the computer and the wireless mobile data communication device ("cc:Mail" address, p. 38, "Sending/Transmitting e-mail messages").

20. With regard to claim 111, AirMobile disclosed the step of causing to send the copy of the user data item to the wireless mobile data communication device over the wireless network further comprises causing to send the copy of the user data item via a wireless gateway disposed between a wide area network and the wireless network (see pg 9, Figure 1-1, a gateway is required to interface between the networks).

21. With regard to claim 112, AirMobile disclosed the step of storing the user data item at the data store associated with the messaging host system (p. 9, "Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored at the communication server, and the mail account is associated with a mobile device according the device ID).

22. Claims 113, 115-122, and 124-129 are rejected using a similar rationale as applied to claims 102-104 and 106-112.

23. Claims 105, 114 and 123 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile Server (AirMobile Wireless Software for Lotus cc:Mail, Communication Server Guide, Motorola, 1995), in view of AirMobile Client (AirMobile Wireless Software for Lotus cc:Mail, Communication Client Guide, Motorola, 1995), and Carthy et al. (MAPI Developers Forum post "MAPI Notification" April 12, 1996; hereinafter Carthy) and Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston") and further in view of Murota (U.S. Patent No. 6,289,105).

Note, the AirMobile Server and AirMobile Client guide present different aspects of the same system, and are therefore are treated as a single system for the purposes of this rejection. They are hereinafter referred to together as "AirMobile" with specific citations to the Server • guide as "AirMobileS" and the Client guide as "AirMobileC."

24. With regard to claim 105, 114 and 123, AirMobileS disclosed sending messages from the cc:Mail server to the mobile device in a secure fashion (AirMobileS, p. 25, bullet 1 "secure and authenticated virtual wireless communication channel between your laptop and your LAN-based cc:Mail server") however, AirMobile does not disclose using encryption for sending messages in a secure fashion. Nonetheless the use of encryption to send messages securely was widely known in the art at the time of Applicant's invention, as evidenced by at least Murota.

In a similar email system, Murota disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then

transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, lines 49-53).

Thus, given the teaching of Murota, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention include an encryption function, as taught by Murota, in conjunction with the redirector component of AirMobile such that messages sent between the AirMobile server and mobile devices are encrypted, in order to prevent outside parties from having access to secret or classified messages.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Examiner, Art Unit 2448